REMARKS

Claims 1-8, 16, 28, and 29 are pending and examined on merits. No amendments are proposed herein.

Regarding 35 U.S.C. § 112, First Paragraph (Written Description)

Applicants respectfully traverse the rejection of claims 1-8, 16, 28 and 29 under 35 U.S.C. §112, first paragraph, for allegedly containing subject matter not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors, had possession of the claimed invention at the time the application was filed.

It is respectfully submitted to be unclear how the Examiner justifies maintaining this rejection. Unless the Examiner can provide authority for the proposition that, even if express written description is present, such written description is mooted by any descriptions in the specification that are silent on the claimed subject matter, this rejection should be withdrawn.

The Examiner concedes that original claims 1 and 10 have support for an antibody binding to SEQ ID NO: 68, and modulating the biological activity of a malignant cell that express a frizzled 5 receptor. The claims as filed in the original specification are part of the disclosure and therefore, if an application as originally filed contains a claim disclosing material not disclosed in the remainder of the specification, the applicant may amend the specification to include the claimed subject matter. *In re Benno*, 768 F.2d 1340, 226 USPQ 683 (Fed. Cir. 1985). The specification, at page 22, lines 306, explicitly defines the claim phrase "modulating a biological activity of a malignant cell" to include, inter alia, as cell growth inhibition (Claim 1) or the ability to elicit a cytotoxic response (Claim 28) to the malignant cell.

The original claims and specification thus provide explicit written description for the subject matter of claims 1-8, 16, 28 and 29. However, the Examiner appears to assert that because "the specification as originally filed does not specifically point out the antibody to SEQ ID NO: 68 would have the activity" the explicit written description in the original specification and claims is somehow discounted. The proposition that written description is somehow neutralized by the presence of additional disclosure that is directed to additional, non-contradictory embodiments, is

The specification thus provides explicit written description for the subject matter of claims 1-8, 16, 28 and 29 and removal of the rejection under 35 U.S.C. §112, first paragraph, for allegedly containing new matter is respectfully requested.

Regarding 35 U.S.C. § 103

Applicants respectfully traverse the rejection of claims 1-8, 16 and 28-29 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Tanaka et al., *Proc. Natl. Acad. Sci. USA* 95:10164-10169 (1998) in view of U.S. Patent No. 5,677,171 (Hudziak et al.).

A prior art reference that "teaches away" from the claimed invention is a significant factor to be considered in determining obviousness; however, "the nature of the teaching is highly relevant and must be weighed in substance." In re Gurley, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994) Applicants argued that Tanaka et al. show that the frizzled 5 receptor *lacks* the differential expression in human esophageal carcinomas that was observed with FzdE3 and was the very reason for the authors of Tanaka et al. to conclude a potential role for FzdE3. Applicants argued previously and now maintain that this provides a strong teaching away. The Examiner has deemed Applicants previous response unpersuasive. Instead of a substantive rebuttal, the Examiner compares the teaching of Applicants specification to Tanaka et al. arguing, *inter alia*:

> The disclosure of Tanaka et al. is similar in that the instant specification discloses frizzled 2 data (Fig. 5 and 6), while Tanaka et al., discloses frizzled 3 data.

Applicants respectfully point out that the Examiner is impermissibly comparing the Tanaka et al. reference to the Applicants' disclosure. It is Applicants' claims that are rejected and that have to be compared to any cited references. Whether or not the specification includes frizzled 2 data is irrelevant to the question of whether or not Tanaka et al., in combination with Hudziak et al., which effectively describes conditions for producing antibodies that are based on

known tumor enhancing growth factor activities of the targets that do not include the frizzled 5 receptor, render obvious the claimed invention.[1]

In sum, Applicants maintain that Tanaka et al. teaches way from the claimed invention by showing that the frizzled 5 receptor lacks the differential expression in human esophageal carcinomas that was observed with FzdE3 and by proposing a potential role for FzdE3 in the pathogenesis of the condition without making a similar prediction with regard to frizzled 5. The silence of Tanaka et al. on frizzled 5 is compounded by the author's admission that the role of frizzled 5 in cancer was unexplored (see citation above). Therefore, Tanaka et al. effectively discourages targeting the frizzled 5 receptor and represents a teaching away from the claimed invention.

In view of the above, Applicants respectfully request removal of claims 1-8, 16 and 28-29 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Tanaka et al., *Proc. Natl. Acad. Sci. USA* 95:10164-10169 (1998) in view of U.S. Patent No. 5,677,171.

CONCLUSION

In light of the remarks herein, Applicants submit that the claims are now in condition for allowance and respectfully request a notice to this effect. The Examiner is invited to call the undersigned attorney if there are any questions or if it is believed that a telephonic interview may expedite prosecution.

[1] It is likewise irrelevant to the question of patentability under section 103 of the code whether or not SEQ ID NO:68 is described in the art. See Office Action mailed 2/25/08 at p.4. Applicants are not claiming SEQ ID NO:68 as a composition.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 502624 and please credit any excess fees to such deposit account.

Respectfully submitted,

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